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HOESSEL et al.

Serial No.: 09/771,595

Atty Docket: 51186

- **Request for Reconsideration**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION

ATTY. DOCKET: PF51186

OF: HÖSSEL ET AL.

CONFIRMATION No.: 8957

SERIAL No. 09/771,595

GROUP ART UNIT: 1616

FILED: JANUARY 30, 2001

EXAMINER: MARINA LAMM

FOR: COSMETIC OR DERMATOLOGICAL SUNSCREEN PREPARATIONS

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REQUEST FOR RECONSIDERATION

Sir:

In reply to the Office action of June 03, 2005, and further to applicants' Notice of Appeal dated September 06, 2005, it is respectfully requested that the following request for reconsideration be entered and considered by the Examiner:

REQUEST FOR RECONSIDERATION

Claims 1 to 4 and 9 to 19 as presented with applicants' paper dated November 06, 2003, are currently pending in this application.

The Examiner maintained that Claims 1 to 4 and 9 to 19 were unpatentable under 35 U.S.C. §103(a) in light of the teaching of *Dieing et al.* (EP 0 893 117) when taken in view of the disclosure of *Tanner et al.* (US 5,827,508) and of *George et al.* (US 6,165,449).

The Examiner essentially reiterated her position adding, in view of applicants' earlier remarks,

- that a person of ordinary skill in the art would have reasonably expected that the surface treated zinc oxide which is addressed in the disclosure of *Tanner et al.* would remain on the hair be-

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cause (1) the zinc oxide is in the form of very small particles and (2) the zinc oxide is surface treated with materials which improve its dispersability in the composition, and

- that *Tanner et al.* specifically teach that their compositions are physically stable, ie. resist phase separation.

It is respectfully urged that the respective arguments are not deemed to support the Examiner's position that a person of ordinary skill in the art would have been motivated to incorporate the surface treated zinc oxide addressed in the disclosure of *Tanner et al.* into the hair treatment composition taught by *Dieing et al.*

The Examiner's reasons why a person of ordinary skill in the art would reasonably expected the surface treated zinc oxide to remain in the hair are not deemed to support that the motivating force is present in the art which is necessary for a person of ordinary skill to do what applicants have done. On the one hand it is noted that the disclosure of *Tanner et al.* merely provides that compositions which comprise the surface treated zinc oxides exhibit improved storage stability, ie. the tendency of the composition per se to undergo phase separation is reduced.¹⁾ However, this property of the surface treated zinc oxide is, in and of itself, only of interest to a person of ordinary skill in the art if such a person is faced with the question which form of zinc oxide is most likely to be suitable for a composition which is designed to comprise zinc oxide. That is: if a person of ordinary skill in the art wants to provide zinc oxide in a particular cosmetic preparation, then the disclosure of *Tanner et al.* can be taken to motivate such a person of ordinary skill to use surface treated zinc oxide instead of another form of zinc oxide.

On the other hand, it is respectfully noted that the improvement of the storage stability of skin cosmetic compositions which is addressed in the disclosure of *Tanner et al.* and which is achieved when surface treated zinc oxide is used instead of non-treated zinc oxide is not deemed to provide the requisite suggestion or motivation which is necessary for a person of ordinary skill in the art to do what applicants have done.

Where applicants' invention and the prior art referenced by the Examiner are concerned, it is first necessary to determine whether a person of ordinary skill in the art would have been motivated to

1) Cf. in particular col. 3, indicated line 41, to col. 4, indicated line 16, of US 5,827,508.

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introduce any form of zinc oxide into the hair conditioning compositions which are taught by *Dieing et al.* With regard to the motivation to use any zinc oxide in a hair conditioning composition the Examiner essentially takes the position

- that it was known in the art to employ UV protecting agents in skin and hair cosmetics, and
- that it is known in the art to employ any zinc oxide as a UV protecting agent.

Based on this state of the art the Examiner argues that a person of ordinary skill would have employed zinc oxide, for example in the surface treated form described in the disclosure of *Tanner et al.*, as a UV protecting agent in the hair conditioning composition of *Dieing et al.*

Applicants' respectfully reiterate their position that the mere fact that zinc oxide is known as a UV protecting agent, and that UV protecting agents are conventionally employed in cosmetic products, is not enough to motivate a person of ordinary skill in the art to employ zinc oxide in the hair conditioning products addressed in the teaching of *Dieing et al.*, ie. to modify the composition of *Dieing et al.* as is necessary to arrive at applicants' composition.

Assuming arguendo that the Examiner is correct and a person of ordinary skill in the art would reasonably expect that the surface treated zinc oxide remained on the hair, such a person of ordinary skill in the art would, equally reasonably expect that the zinc oxide which remains on the hair dulls the hair color and thereby interferes with the healthy appearance of the hair. Zinc oxide is a white or yellowish pigment, independent of the particle size or the surface treatment,²⁾ and zinc oxide which remained in the hair as the Examiner would have it would therefore have to be expected to form a whitish or yellowish residue on the hair. In accordance with the Examiner's line of argument, a person of ordinary skill in the art would have to consider it advantageous to obtain a storage stable hair conditioner, without regard whether the hair conditioner will then, actually convey a healthy appearance to the hair. The respective approach is not deemed realistic because the utility of the hair conditioning composition addressed by the teaching of *Dieing et al.* would clearly be impaired under those circumstances. If a proposed modification would render the prior art invention which is being modified unsatisfactory

2) Cf. eg. col. 6, indicated lines 21 to 35, of *US 5,827,508*.

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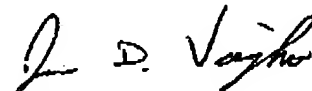
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for its intended purpose, then there is no suggestion or motivation to make the proposed modification.³⁾ Under the assumption made by the Examiner that the surface treated zinc oxide addressed in the disclosure of *Tanner et al.* remained on the hair, the hair conditioning composition taught by *Dieing et al.* is rendered unsatisfactory for its intended purpose, so that the motivation to make the modification which is necessary to arrive at applicants' composition is lacking.

Accordingly, the Examiner's arguments support that applicants' invention was not rendered obvious under Section 103(a) by the teaching of *Dieing et al.* and the disclosures of *Tanner et al.* and of *George et al.* It is therefore respectfully urged that the rejection of Claims 1 to 4 and 9 to 19 be withdrawn. Favorable action by the Examiner is solicited.

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Respectfully submitted,
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3) Cf. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (CAFC 1984).